

REMARKS

Claims 1-17 are pending.

On page 3, paragraph 7 of the Office Action the Examiner indicates that applicant's arguments filed February 8, 2005 have been considered but they are not persuasive. In particular, the Examiner refers to applicant's arguments relating to the 112(1) rejection of claims 1-17 that persons of ordinary skill in the art would be readily aware of many means by which survey participant's responses could be compared. At paragraph 8 of page 3, however, the Examiner states that the applicant's arguments with regard 112(1)(2) rejections of claims 1-17 are deemed persuasive and that the rejections under §112(1)(2) have been withdrawn. Applicant assumes that the 112(1) rejections have, in fact, been withdrawn.

The claims remain rejected under §101 as being directed to non-statutory subject matter. As noted in applicant's reply of February 8, 2005, applicant disagrees with the PTO's position that subject matter must both provide a useful, concrete, and tangible result and be within the technological arts (whatever that means) to be statutory. Setting that question aside and assuming the Examiner's position is correct, however, the Examiner's rejection of the claims still does not make sense.

The Examiner admits that the subject matter claimed in this application produces a useful, concrete, and tangible result. (Office Action at 4). The Examiner did not address the applicant's arguments that the subject matter of this application is within the technological arts, even adopting the Examiner's definition of technological arts. As noted at page 12 of the February 8th reply, the claimed invention is clearly performed with the aid of a computer. Claim 1 (the only independent claim) recites, for example, "presenting one or more consumer products to the user over a distributed "network" and presenting a questionnaire to the user over the distributed network." Claim 1 also recites "accepting and storing" the user's first and subsequent responses to the questionnaire, which, in the context of a "method for surveying an online user" "over a distributed network" clearly refers to computer implemented steps.

The Examiner contends that claims 1-17 are nonstatutory and are not limited to the technological arts because "a human could perform all recited steps manually." (Office Action at 8). Clearly, a human could not perform the computer implement steps recited above

manually.

Furthermore, in the context of the prior art rejections, the Examiner acknowledges that the claimed invention is "within the technological arts." The prior art rejection is based on the combination of Dyer, which describes a non-computerized methodology for sustainability testing, combined with Pitkow, which describes using the web as a survey tool. Obviously, the Examiner recognizes that a rejection based on Dyer alone would not be proper since the claimed invention is not anticipated by the non-computerized sustainability testing method described in Dyer. Furthermore, the Examiner states that "the disclosed invention merely represents the obvious evolution of the methodology for sustainability testing as taught by Dyer et al. via the utilization of online (computer-based) surveys and therefore does not rise to the level of a novel or non-obvious invention." (Office Action at 11). While the applicant strongly disagrees with the Examiner's contention that the claimed invention is an "obvious evolution" of the sustainability testing taught by Dyer, the Examiner's statement is a clear acknowledgment that the claimed invention is within the technological arts and that a human could not perform all the recited steps manually.

For the foregoing reasons, applicant submits that the claimed invention is statutory, even within the Examiner's two-part definition of statutory subject matter, and applicant respectfully requests that the §101 rejection be withdrawn.

Claims 4, 6, 7, 9, and 11 stand rejected under 35 U.S.C. §112, second paragraph, because the limitation "the item" lacks antecedent basis. These Claims have been amended to change the term "item" to "consumer product". Accordingly, withdrawal of the rejection under §112, second paragraph, is respectfully requested.

Claims 1, 3-5, 11, 13-14, and 16 stand rejected as being unpatentable over Pitkow in view of Dyer. Applicant respectfully traverses the rejection.

Dyer describes a method for sustainability testing of consumer products, and in particular, snack-food products. While Dyer acknowledges that there are numerous methods known in the art for evaluating products, including food products, by members of the consuming public (col. 1, lns 14-16), the sustainability testing method described in Dyer is a highly specialized and focused methodology that is significantly different from the then-known

methods for evaluating a product. In fact, Dyer was awarded a patent for the sustainability testing methodology described over the then-known prior art methods.

The methodology described in Dyer involves providing repeated cycles, or "waves," of test materials to panel members. Test materials may include video and/or printed materials and optionally samples of one or more products of a test set of products. Consumers may order products from the test sets, and the choices are recorded to ascertain preference data. (col. 2, ln. 19 - col. 3, ln 64). The process is repeated over subsequent cycles, and consumer preference data is obtained by monitoring the products ordered by the consumer to determine the ability of any given product to "win over" the consumer (col. 2, lns 59-62).

The Pitkow article merely describes using the web as a survey tool. The authors describe the results of a user survey that was made available to the web user population for a limited period of time. Users were invited to participate in the survey, and if the users accepted the invitation, a survey questionnaire was presented. The survey questionnaire included adaptive questions whereby answers provided to certain questions were used to determine a subsequent series of questions. The survey follows a cycle of question-answer-adapt-reask, and repeats the cycle until all questions have been satisfactorily answered.

To make out a *prima facie* case of obviousness based on the modification or combination of one or more prior art references, there must be some motivation that would cause a person of ordinary skill in the art to modify and/or combine the prior art references to derive the claimed invention. The fact that a person of ordinary skill in the art could have modified and/or combined the teachings of the prior art reference(s), or the fact that, based on the teachings of the prior art, it would have been obvious to try the claimed subject matter, is not sufficient to establish obviousness of an invention under §103. The motivation to combine or modify the prior art can come from the teachings of the prior art, the nature of the problem solved by the claimed subject matter, and the knowledge of persons of ordinary skill in the art. Moreover, a *prima facie* case of obviousness requires that the prior art relied upon for the rejection teach or suggest all of the elements of the rejected claim(s).

The rejection based on the combination of Pitkow and Dyer is traversed on the grounds that (1) the cited combination of references does not teach or suggest all of the elements of the

rejected claims, and (2) there is no motivation for combining the references to derive the claimed invention.

With respect to independent claim 1, the cited art does not describe “presenting one or more consumer products to the user over a distributed network,” “presenting a questionnaire to the user over the distributed network if the user selects at least one of the consumer products presented,” or “performing online sustainability testing by comparing the user’s first response to the user’s subsequent response(s).” With respect to dependent claim 3, the cited art does not teach or suggest “present a first consumer product and a second consumer product [and asking questions] about the first and second consumer products.” With respect to claim 4, the cited art does not teach or suggest “presenting a questionnaire to the user only [] if the user selects both the first and second products.” Thus, the cited combination of Pitkow and Dyer does not teach all of the elements of at least claims 1, 3, and 4.

Furthermore, there is no motivation for combining the teachings of Pitkow and Dyer to derive the subject matter of the rejected claims. The Examiner states that it “would have been obvious to one skilled in the art at the time of the invention that the system and method for conducting online surveys as taught by Pitkow would utilized [sic] the ability to conduct more in-depth-consumer surveys by applying the method of sustainability testing in view of the teachings of Dyer et al.” (Office Action at 15). The Examiner has cited no evidence in support of his assertion that implementing a sustainability testing method as described in Dyer in an online format using the adaptive survey methodology described in Pitkow would result in more in-depth consumer product surveys. Furthermore, as described above, the sustainability methodology of Dyer and the current invention, is a specialized consumer preference data gathering methodology for ascertaining consumer preferences over a period of time and the sustainability of those preferences. Pitkow merely describes a survey method that is adapted and repeated if respondents do not answer or insufficiently answer one or more questions. To the extent that Pitkow describes consumer surveys, it merely describes a methodology for ascertaining consumer attitudes (e.g., whether it is safe to use credit cards when making purchases from web vendors, and the importance of the security of sensitive information) as well as demographic information such as marital status. (See Pitkow at p11). There is no

suggestion in Pitkow of presenting consumer products over a distributed network and providing a questionnaire to the consumer if they select one or more of the presented products.

With respect to claims 3 and 4, the Examiner acknowledges that Pitkow does not teach that the survey is adapted based on the presentation of a first or a second consumer product as claimed but suggests that:

It would have been obvious to one skilled in the art at the time of the invention that the method for the adaptive surveying of online users as taught by Pitkow, including its applicability to a plurality of survey topics including but not limited to product surveys, would utilize the ability to conduct more in-depth consumer product surveys by applying the method of sustainability testing in view of the teachings of Dyer et al.; the resultant system enabling users to perform online sustainability testing wherein the survey questions are dynamic (i.e. change/adapt based on the questions asked and answered by the survey taker) thereby reducing the number and complexity of questions presented to each user (Pitkow et al.; Paragraph 1, Page 4).

(Office Action at 16-17)

Again, the Examiner has cited no evidence in support of this conclusion that a person of ordinary skill in the art would conclude that the teachings of Dyer and Pitkow lead to more in-depth consumer product surveys. Furthermore, as noted above, to the extent that Pitkow describes consumer surveys, it merely describes ascertaining consumer attitudes and demographics. Also, the Examiner has cited no evidence to support his conclusion that the dynamic questioning described in Pitkow is even applicable to sustainability testing. Sustainability testing involves providing, in multiple cycles, sample consumer products from which the consumer may order one or more products and thereafter ascertaining consumer preferences over an extended period based on the products ordered by the consumer.

Accordingly, applicant submits that the combination of Pitkow and Dyer do not teach all of the elements of claims 1, 3-5, 11, 13-14, and 16. And, moreover, there is no motivation for combining the teachings of Pitkow and Dyer; the rejection based on that combination is no more than a hindsight reconstruction of the claimed invention.

Accordingly, the rejection should be withdrawn.

Claims 2, 12, 15, and 17 stand rejected under §103 as being unpatentable over Pitkow

in view of Dyer and further in view of Official Notice. Claims 2, 12, 15, and 17 depend from independent claim 1 which is believed to be allowable. Accordingly, claims 2, 12, 15, and 17 are also believed to be allowable.

Furthermore, claim 12 recites the steps of "performing offline sustainability testing; and comparing the results of the online and offline sustainability testings." The Examiner acknowledges that Pitkow does not teach the utilization of surveys online or offline to perform sustainability testing. (Office Action at 21). Having no prior art to cite, the Examiner relies upon Official Notice that the comparison of multiple surveys, regardless of the method of conducting those surveys, is old and well known in the art as a means for determining such things as trends between various user communities. (Office Action at 21).¹ The applicant respectfully disagrees. Applicant requests that the Examiner cite a prior art reference in support of his contention that it is old and well known to "[perform] offline sustainability testings; and [compare] the results of the online and offline sustainability testings" or provide his affidavit under 37 C.F.R. §1.104(d)(2). The cited art simply does not teach the limitations of claim 12.

Moreover, there is no motivation for modifying Dyer and/or Pitkow to provide both online and offline sustainability testing and compare the results. The Examiner contends it would have been obvious "that the online sustainability testing as taught by Pitkow in view of Dyer et al., would have benefitted from conducting and comparing both online and offline product sustainability tests as a means for tracking the growth and changes in different user populations." (Office Action at 21). The Examiner cites no evidence in support of this conclusory statement. It is merely a hindsight reconstruction of the claimed invention. There is no suggestion in the prior art that a method for online sustainability testing would have benefitted from conducting both online and offline sustainability testing and comparing the results.

Claims 6-10 stand rejected under §103 as being unpatentable over Pitkow in view of Dyer and further in view of Pinsley (6,070,145). Applicant respectfully traverses the rejection.

Claims 6-10 depend from independent claim 1 which is believed to be allowable.

¹Applicant notes that claim 12 was not rejected based on prior art in the Office Action of October 8, 2004. Accordingly, the current rejection is a new rejection.

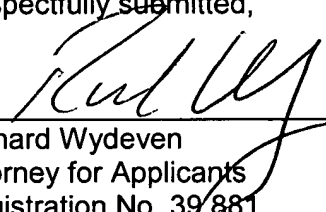
Appl. No. 09/764,338
Amdt. dated August 22, 2005
Reply to Office Action of May 24, 2005

Accordingly, claims 6-10 are believed to be allowable as well. As noted above, the combination of Dyer and Pitkow does not render the method of online sustainability testing of claim 1 obvious because those references do not teach or suggest all elements of the claims and, moreover, there is no motivation for combining or modifying the references to derive the invention of claim 1. The teachings of Pinsley do not overcome the deficiencies of Pitkow and Dyer. Pinsley merely describes a method for selecting a respondent to a survey and describes that survey information may be processed and analyzed by a surveyor before being delivered to an advertiser.

All rejections and objections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a notice to that effect is earnestly requested.

Respectfully submitted,

By


Richard Wydeven
Attorney for Applicants
Registration No. 39,881
ROTHWELL, FIGG, ERNST & MANBECK, p.c.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

914-1464-AM2.wpd